

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE



In re application of: Michael Reasoner

Serial No.: 09/115,764

Group Art Unit: 3682

Filed: July 15, 1998

Examiner: V. Luong

For: CONDUIT SHORTENING ADJUSTMENT ASSEMBLY

REPLY BRIEF

Box AF
Commissioner for Patents
P.O. Box 1450
Alexandria, Virginia 22313-1450

Dear Sir:

The following Reply Brief is in response to the Examiner's Answer mailed on 8/08/2003. All of the pending claims in the subject reissue application stand rejected under 35 U.S.C. § 251 as attempting to recapture subject matter surrendered in the application to obtain the original patent.

A precedential opinion concerning a reissue recapture rejection under 35 U.S.C. § 251 was decided on May 29, 2003 in *Ex parte Eggert*, a copy of which is enclosed¹. This precedential opinion was decided two days after Applicant filed its Appeal Brief. In *Eggert*, the majority opinion applied the analysis set forth in *In re Clement*, 131 F.3d 1464, 1468-71 45 USPQ2d 1161, 1164-66 (Fed. Cir. 1997), and determined that surrendered subject matter was claim 1 of *Eggert* as that claim existed prior to the post-final rejection amendment that led to the allowance of claim 1 in the original patent, and decided that reissue claims 15-22 of *Eggert* were NOT precluded, i.e. were not barred by the recapture

¹ An electronic copy of *Eggert* can be found at
<http://www.uspto.gov/web/offices/dcom/bpai/prec/RC010790.pdf>

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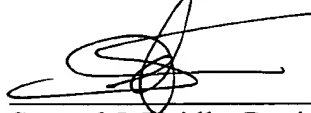
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rule. The majority opinion also stated that the Board **declined** to impose a *per se* rule of reissue recapture to prevent Appellants from retreating from any claim limitation determined to have secured allowance of the original patent. Hence, the focus for determining the reach of the reissue recapture rule should be the claim from which the issued claim directly evolved, not the issued claim itself.

Ex parte Eggert clearly sets forth the Board's opinion of the reissue recapture rule and how the rule is to be applied. Applicant encourages the Examiner to review the *Ex parte Eggert* precedential opinion and to revisit the current recapture rejection. The facts set forth in the subject reissue application and the arguments detailed in Applicant's Appeal Brief are consistent with the *Eggert* decision. In other words, applying the analysis set forth by the Board, *en banc*, in *Eggert* to the current rejections under 35 U.S.C. § 251 even further requires that the rejections of claims 4-29 and 37-40 should be withdrawn.

Respectfully submitted,

HOWARD & HOWARD ATTORNEYS, P.C.



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Date: October 8, 2003

CERTIFICATE OF MAILING

I hereby certify that the attached **Reply Brief** in triplicate and fee are being deposited with the United States Postal Service as first class mail, postage prepaid, in an envelope addressed to the **Box AF, Commissioner for Patents, P.O. Box 1450, Alexandria, Virginia 22313-1450**, on **October 8, 2003**.


Brenda J. Hughes

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